

## REMARKS

In response to the Office Action of December 17, 2003, claim 11 is hereby amended.

Claims 11 and 12 were rejected under 35 U.S.C. § 112, first paragraph and claims 1-8, 11-18 and 21 were rejected under 35 U.S.C. § 102(e), as being anticipated by Pieken *et al.*, U.S. Pat. No. 5,874,532. Claims 9, 10, 19 and 20 were objected to as being dependent on a rejected claim. Each of these rejections is discussed below.

### Rejections under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 11 and 12 under 35 U.S.C. § 112, first paragraph, reasoning that while the Specification is enabling for the first four compounds claimed it does not reasonably provide enablement fro the last two compounds of instant claim 11. In response to this rejection claim 11 has been amended by deleting the last two compounds from the claim. Applicant respectfully requests that this rejection now be withdrawn.

### Rejection under 35 U.S.C. § 102(e)

The Examiner has rejected claims 1-8, 11-18 and 21 under 35 U.S.C. § 102(e) as being anticipated by Pieken *et al.*, U.S. Pat. No. 5,874,532, which has a common inventor with the instant application. With respect to the Section 102(e) rejection Applicant is submitting a Section 132 declaration executed by Wolfgang Pieken, the inventor in common with each of these cases. Applicant respectfully requests that this rejection be withdrawn.

### Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 6 and 7 reasoning that although they define what DDM is they do not further limit instant claim 4. Although not stated by the Examiner, Applicant is assuming that this is a rejection under 35 U.S.C. § 112, second paragraph. Applicant respectfully traverses this rejection for the following reason. Claim 4 is drawn to a generic class of compounds and claims 6 and 7 are drawn are drawn to a limited portion of the generic class of compounds of claim 4. Applicants maintain that all that is required by the second paragraph of Section 112 is that the claims set out and circumscribe a particular area which applicant regards as their invention with a reasonable degree of precision and particularity. There is no statutory

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basis to reject claims as being unnecessary. Applicants are given latitude to present claims of varying scope to the same invention. As set forth by the court in *In Re Lundberg*, "each claim, whether broad or narrow, is, of itself, a separate entity, and each grants a different measure of protection to the inventor." (*In Re Lundberg*, 113 USPQ 530, 534 (C.C.P.A. (1957)).

Applicant believes that the pending claims are now in condition for allowance. If it would be helpful to obtain favorable consideration of this case, the Examiner is encouraged to call and discuss this case with the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117 if not otherwise specifically requested. The undersigned hereby authorizes the charge of any fees created by the filing of this document or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,

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